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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,763	10/17/2001	William Sanford	11009-0021	8838

22865 7590 12/27/2006  
ALTERA LAW GROUP, LLC  
6500 CITY WEST PARKWAY  
SUITE 100  
MINNEAPOLIS, MN 55344-7704

EXAMINER
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AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/981,763

Applicant(s)

SANFORD, WILLIAM

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 32-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/10/2006 has been entered.

### ***Rejections Withdrawn***

2. Claims 32-43 are rejected under 35 U.S.C. 112, first paragraph, made in the last Office action of 3/9/2006 has been withdrawn in view of the amendment filed on 10/10/2006 (except for the new matter rejection for "alignment of the linear wedge of the label" in claim 32).
3. Claims 32-38 and 40-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Riley (6685228) made in the last Office action of 3/9/2006 has been withdrawn in view of the amendment filed on 10/10/2006.
4. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riley made in the last Office action of 3/9/2006 has been withdrawn in view of the amendment filed on 10/10/2006.

***Response to Arguments***

5. Applicant's arguments with respect to claims 32-43 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 32-38 and 40-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Riley (6685228).

Riley discloses an alignable label system (22) comprising a label sheet (20) having a central split line (38), the label sheet having a line (32) separating a label from a second portion (36). The system further comprises a backing member or laminating strip (44) applied to the label and having a split line (48). An alignment section on the second portion is separable from the label and includes an edge to conform to the edge of a folder (abstract). Further, Riley as discloses a method of aligning and applying a label to the edge of a folder comprising the steps of removing a portion of the backing member from the label, aligning the alignment section to the edge of the folder, applying the label, peeling of the remaining backing member and folding the label over the edge (col.

9, lines 4-16). Figures-4 and 5 shows that the alignment line can be curved shaped (82 or 84) and is proximate at least one end of the label.

The top side of the label is adapted for printing (col. 4, lines 34-38).

As shown in figures 4 and 5, the curved edge is "S"-shaped.

The label is adhesive (28) on the surface contacting the backing member.

Figure-4 shows a plurality of labels with die-cut lines therebetween.

The intended use phrases such as "for two dimensional alignment", "wherein when one portion... is affixed to the folder", "for accurate alignment", "when a portion", etc. have not been given any patentable weight because said phrases are not found to of positive limitations.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riley.

Riley, as discussed above, fails to teach that the curved portion on the second portion is spaced from the label. It would have been obvious to one having ordinary skill in the art at the time the invention was made to space the label from the curved portion because, as seen in figure-4 of Riley, the curved portion (82) is perforated and hence, would have

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tie portions between the cut portions. The tie portions would provide for the spacing of the curved portion from the label.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 32-33 and 37-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 32, the phrase "alignment of the linear edge with the label" is found to be new matter because said phrase is not supported by the specification as originally filed.

Claim 38, the phrase "a discardable portion" in section (c ) is also found to be new matter for lack of support in the original specification.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 32-33 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32, the phrase "said label sheet" is found to be indefinite for lack of antecedent basis.

### ***Response to Arguments***

14. Applicant's arguments filed 10/10/2006 have been fully considered but they are not persuasive.

Applicant argues that Riley is not a prior art in view of the declaration by William Sanford under 37 CFR 1.131. This is not found to be convincing because the declaration is not accompanied by or as part of the affidavit of the original exhibits of drawings or records, etc. as required by 37 CFR 1.131 (b). See MPEP 715. thus, as applied hereinabove, Riley is found to be a proper reference.

In response to applicant's explanation that the terminology rejected under 35 USC 112, first paragraph have been removed, applicant should note that not all the languages have been removed as alleged. Applicant is requested to review the claim languages carefully and remove the languages as admitted by the applicant.

Thus, in the absence of any evidence to the contrary, it remain the examiner's position that the claimed invention is anticipated or rendered obvious and rejected under 35 USC 112, first and second paragraphs for reasons discussed hereinabove.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-

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1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Nasser Ahmad 12/21/06  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
December 21, 2006.